

This Opinion is Not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: February 20, 2015

Opposition No. 91211008

Executive Transportation Services of
WNY, Inc.
v.

Buffalo Niagara Chauffeured Services,
Inc.

Before, Bergsman, Wolfson and Goodman, Administrative Trademark
Judges.

Opinion by Goodman, Administrative Trademark Judge:

Applicant, Buffalo Niagara Chauffeured Services, Inc. (hereinafter “Applicant”) seeks registration of BUFFALO LIMOUSINE, in standard character form, for “limousine services” in International Class 39.¹ In its amended notice of opposition, Opposer, Executive Transportation Services of WNY, Inc. (hereinafter “Opposer”) alleges that Applicant’s mark is merely descriptive, primarily geographically descriptive, geographically misdescriptive,² generic, or functional. In its answer, Applicant admitted Opposer’s paragraph 2, that it “filed trademark application Serial Number

¹ Application Serial No. 85791624 filed under Section 1(a); “Limousine disclaimed,” Section 2(f) claimed as to the mark.

² We construe this as an allegation the mark is geographically deceptively misdescriptive, which Opposer confirms in its response to the motion for involuntary dismissal.

85791624 on November 30, 2012 for the mark BUFFALO LIMOUSINE associated with 'Limousine services' in International Class 039." In paragraph 3, Opposer alleges that "Applicant primarily offers limousine services in the city of Buffalo, New York." Applicant admitted paragraph 3 in part in "that it provides limousine services in Western New York and avers that it promotes it [sic] services throughout the United States and provides services through affiliated companies throughout the United States." Applicant denied the other allegations in the notice of opposition and asserted affirmative defenses.

Pursuant to the Board's order of June 2, 2014, Opposer's testimony period closed on October 7, 2014. During its testimony period, Opposer did not take testimony or introduce any evidence.

Motions to Dismiss and to Reopen

This case now comes up on Applicant's motion, filed October 8, 2014, for involuntary dismissal under Trademark Rule 2.132(a), for Opposer's failure to take any trial testimony or offer any evidence in support of its claims. Opposer filed a response and cross-motion to reopen on October 23, 2014, which Applicant opposed.

Trademark Rule 2.132(a) states that if the time for taking testimony by the plaintiff has expired and the plaintiff has not taken testimony or offered any other evidence, the defendant may move for dismissal on the ground of failure to prosecute and, that in the absence of a showing of good and sufficient cause by plaintiff, judgment may be rendered against plaintiff.

The “good and sufficient cause” standard, in the context of this rule, is the equivalent of the “excusable neglect” standard which would have to be met by plaintiff under FRCP 6(b)(1)(B) to reopen plaintiff’s testimony period. *See Grobet File Company of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989), and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982).

In determining these motions, the Board considers the following excusable neglect factors as set forth in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), and adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997): (1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and (4) whether the moving party has acted in good faith.

Opposer argues that the length of delay is “minor” as Opposer’s testimony period just ended and Applicant will not suffer prejudice if Opposer’s testimony period were reopened. Opposer also argues that it acted in good faith as it believed “there was enough in the Applicant’s Answer to move the case forward to the Applicant’s testimony period.” Opposer did not directly address the third *Pioneer* factor, reason for delay. We address *infra* Opposer’s argument that the admissions in Applicant’s answer preserved its right to proceed to trial.

In response to the motion to reopen, Applicant argues that Opposer has not established excusable neglect. Applicant further argues that reopening this proceeding “would cause substantial prejudice” to Applicant.

With regard to the first and fourth *Pioneer* factors, we find no specific prejudice to Applicant beyond mere delay, and we find no specific evidence of a bad faith attempt by Opposer to delay this case. We find these *Pioneer* factors neutral.

With regard to the second *Pioneer* factor, we find that the delay has a significant potential impact on the Board proceeding because we consider not only the timing of the motion to reopen but the additional delay that results from briefing and ruling on the motion to reopen. Accordingly, this factor weighs against Opposer.

With respect to the third and most important *Pioneer* factor, Opposer has provided no explanation for the reason for delay other than its reliance on Applicant’s answer. In view of Opposer’s failure to address the circumstances surrounding the delay, we find that this *Pioneer* factor weighs against Opposer.

After careful consideration of the *Pioneer* factors and the relevant circumstances in this case, we find that Opposer has failed to make the requisite showing of excusable neglect to support reopening of its testimony period. In view thereof, Opposer’s motion to reopen is denied.

Whether the admissions in Applicant's answer preserve enough of an issue to reset remaining testimony periods

Opposer has not introduced any evidence into the record or taken testimony. Before turning to consideration of whether the admissions in the answer would allow this proceeding to continue to final hearing, we note that Opposer has not asserted that the admissions in the answer support its genericness or functionality claims. Therefore we consider these claims waived. *Cf. Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (considering claims not argued in brief to have been waived).

With regard to the descriptive and primarily geographically descriptive claims in the notice of opposition, we note that these claims are irrelevant.³ By seeking registration on the basis of Section 2(f), Applicant effectively has conceded that the proposed mark is, at a minimum, descriptive or geographically descriptive of the identified services. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive”).

Therefore, an opposer who seeks to oppose a Section 2(f) application on descriptive or primarily geographically descriptive grounds must include an

allegation that the mark lacks acquired distinctiveness in the notice of opposition. Although Opposer makes a conclusory statement in its response to the motion to dismiss that “Applicant has not proved any secondary meaning,” Opposer has not included any such allegations related to lack of acquired distinctiveness in the notice of opposition. Moreover, since Opposer did not introduce any testimony or evidence, those claims could not have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)(2). Accordingly, we consider the descriptive and primarily geographically descriptive allegations in the notice of opposition to constitute unpleaded claims which we need not entertain. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 115 n.3 (TTAB 2009) (although dilution argued in trial brief, such arguments were not considered as the dilution claim was unpleaded).

Therefore, we only consider whether the admissions in the answer preserve an issue as to the geographically deceptively misdescriptive claim so that remaining trial dates can be reset and this case can proceed to final decision. *Litton Business Systems, Inc. v. JG Furniture Company, Inc.*, 188 USPQ 509 (TTAB 1976).

Opposer argues that “Applicant admitted [in the answer] to using the mark in other locations which makes the mark geographically mis-descriptive.”

³ In arguing descriptiveness, Opposer points to the application file which is automatically of record in this proceeding. Trademark Rule 2.122(b).

Applicant, on the other hand, argues that Applicant's admissions do not address Opposer's burden to establish standing and that Opposer's "arguments concerning descriptiveness are irrelevant."

We first consider whether there are any admissions in the answer as to standing, which is an element in every Board case. In the absence of an admission or stipulation from an applicant, it is incumbent upon the opposer to establish its standing. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982).

In this case, Applicant has not admitted in its answer that Opposer is a competitor of Applicant or that Opposer is in a position to use the term "Buffalo limousine" in a descriptive manner in connection with Opposer's limousine services. Notice of Opposition paragraphs 1, 4, 5 and 6. Therefore, Opposer's standing has not been admitted by Applicant. Moreover, even if there had been an admission by Applicant as to Opposer's standing, Applicant's admission that it also provides limousine services outside of the Buffalo area does not of itself establish Opposer's geographically deceptively misdescriptive claim. There is no admission, for example, that a substantial portion of consumers would be materially influenced in the decision to purchase Applicant's services by the geographic nature of the involved mark.

Accordingly, inasmuch as there is no evidence of record on which Opposer can meet its burden of proof as plaintiff, Applicant's motion for involuntary dismissal is granted, judgment is hereby entered against

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Opposer and the opposition is hereby dismissed with prejudice. Trademark
Rule 2.132(a).